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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/593,060	06/13/2000	Tatsuya Eguchi	52178-020	5731
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MCDERMOTT WILL & EMERY LLP			HAN, QI	
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WASHINGTON, DC 20005-3096			PAPER NUMBER	
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DATE MAILED: 12/27/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/593,060	Applicant(s) EGUCHI ET AL.	
	Examiner Qi Han	Art Unit 2654	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 November 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-18 is/are rejected.
- 7) ☒ Claim(s) 1 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Response to Amendment

2. This communication is responsive to the applicant's amendment filed on 09/26/2005.
Applicant amended claim 1.

The examiner withdraws the claim rejection under 35 USC 112, since applicant amended the claim(s) and/or clarified part of the claimed limitations.

Response to Arguments

3. Applicant's arguments filed on 09/26/2005 with respect to claims 1-18 under 35 USC 103 have been fully considered but they are not persuasive. It is noted that even though the applicant amended claim 1, the claims and the argument still cannot overcome a rejection based on the previous cited references (see detail claim rejection below).

In response to applicant's arguments with respect to claim 1 (also applied to claim 14) that that "the rejection are respectfully traversed" particularly for limitations "**controls said output unit so as to output the translated document data by groups**" and "**controls said output unit so as to output the translated document data translated into the first and second language as a common group**" (amendment: page 12), Primary reference (Yamauchi)

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“never discloses or suggests” the claimed limitation (amendment: page 13, paragraphs 1-2), and if combining Yamauchi with Flores (secondary reference), it will result in different outcome from the claimed limitation (amendment: page 13, paragraph 3 page 14, paragraph 3), the examiner respectfully disagrees with applicant’s arguments and has a different view of the prior art teachings and the claim interpretations.

It should be pointed out that the scope of the claimed limitations is broader than that of argument, because the claimed limitation “output...” is not limited by printing on paper. Further, it is noted that Yamauchi teaches both a general feature of outputting document in the first and/or second languages (col. 4, lines 37-52) and specific feature of outputting document in the first and second languages on two side of a sheet (col. 4, lines 53-60), including outputting text data to a personal computer through telecommunication (col. 7, lines 52-59), which clearly suggests that Yamauchi does not limited his invention only for the specific feature argued by the applicant (amendment: pages 13-14).

Furthermore, as stated in the claim rejection, Flores teaches translation of documents in multiple languages and a variety of formats and using computer displaying in two or more separate languages (col. 3 lines 67 to col. 4, line 10 and Figs. 2-6). It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Yamauchi by providing translation of documents in multiple languages and a variety of formats and using computer displaying in two or more separate languages, as taught by Flores, for the purpose of being beneficial to users presenting and displaying a written text and its multiple translations in two or more separate languages (Flores: col. 4, lines 5-8). Therefore, the combined system by the two references has capability of implementing the feature of the claimed and argued

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limitations in claims 1 and 14, wherein the output of a document by respective paragraphs and their orders (Yamauchi: Fig. 24, col. 5, lines 56-67) and viewing and choosing two or more languages presented adjacently on display (Flores: col. 6, lines 47-54 and Figs. 3-5B) can be, at least in sense of broadest reasonable interpretation, read on the claimed/argued “output ...by groups” (claim 1) and “output ...by a common group” (claim 14).

4. The response to applicant's arguments with respect to claims 6, 11 and 17 is based on the same or similar reason as described for claims 1 and 14 (see above). Further, it is noted that the claimed limitations (in claims 6, 11 and 17) are not the same as the argued recitation “a document including...” (see amendment: page 14, paragraph 4). In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., “a document including...”) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). Furthermore, it should be pointed out that the limitation “document data” is broad and can be interpreted in many ways, including a single or multiple documents, files, pages, paragraphs, sentences, phrases, words (tokens), content tables, database text records, any combination thereof, etc., so that the combined reference teachings in the rejection are properly read on the claimed limitations, based on broadest reasonable interpretation of the claims.

In addition, in response to applicant's argument regarding establishing a *prima facie* basis, the examiner recognizes that obviousness can only be established by combining or

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modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, a prima facie case is based on the prior art teachings, because both references (Yamauchi and Flores) teach to solve the same or similar problems that includes translating document and outputting one or more documents in different languages, by using a computer system. As stated in the claim rejection, Yamauchi's invention can translate a first language into a second language and output the first language and the second language, and Flores's system can translate and output multiple languages. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Yamauchi by providing translating and outputting multiple languages, as taught by Flores, for the purpose (motivation) of being beneficial to users presenting and displaying a written text and its multiple translations in two or more separate languages (Flores: col. 4, lines 5-8). Thus, the prima facie basis is properly established.

Claim Objections

5. Claim 1 is objected to because of the following:

Regarding claim 1, the amended claim limitation "the language of each language group **consisting of** one of the plurality of languages" (amendment: page 2) is different from the argued limitation "the language of each language group **being** one of the plurality of languages". It is

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reminded that the limitations in different words might have different interpretations. Appropriate correction or confirmation is required.

Claim Rejections - 35 USC § 103

6. Claims 1-2, 4-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yamauchi et al. (5,701,497) hereinafter referenced as Yamauchi, in view of Flores et al. (6,370,498 B1) hereinafter referenced as Flores.

As per **claim 1**, Yamauchi teaches a translating apparatus comprising:

“translating means for translating document data into another language” (Fig.1 and col. 7, lines 41-54, ‘translation unit 9’);

“an output means for outputting the translated document data translated by said translating means” (col. 4, line 36 to col. 5, line 11, ‘output means for outputting said received document (including translated document data); Fig. 1, ‘bitmap exp 10’ and ‘plotter 11’, ‘PC/WS 12’; col. 7, lines 54-55, ‘the translating unit 9 supplies the output text data...for transfer to the personal computer 12’);

“a mode setting unit for setting the translating apparatus in a first mode or a second mode” (col. 4, lines 36-60, ‘wherein one of said first and second output means is selectively activated (mode setting)’);

“a controller”, (col.,7, lines 55-56, ‘the system of Fig. 1 includes a system controller’, which necessarily controls each unit, such as ‘OCR’, ‘translation’ and ‘outputs text data representing the result of translation’);

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“wherein, in a case where the first (or second) mode is set, said controller controls said translating means so as to translate the document data into” a target language “different from [one another] an original language of the document data” and “controls said output unit so as to output the translated data”, (col. 4, lines 39-45, ‘translating a received document, written in a first language, to a second, different language...output...in said second language... wherein one of said first and second output means is selectively activated (setting mode)’; col.7, line 48, ‘outputs text data representing the result of translation’);

“wherein, in a case where the second mode is set, said controller controls said translating means so as to translate the document data into” a target language “different from [one another] an original language of the document data” and “controls said output unit so as to output the translated data translated by groups, each group of the translated document data comprising the original language and the translated document data”, (col. 4, lines 39-45, ‘translating a received document, written in a first language, to a second, different language...output means for outputting...simultaneously (another mode) in said first language and said second language’; Fig. 24, shows the output of the document in the original and target languages by respective paragraphs and their orders (interpreted as by group)).

But, Yamauchi does not explicitly teach translating “the document data into a **plurality of languages** different from one another” and outputting the data by certain group(s). However, this feature is well known in the art as evidenced by Flores who discloses apparatus and methods for multilingual user access (title), comprising that ‘the database stores translation of documents in multiple languages and a variety of formats’, ‘user can choose to have the multiple translations’ and ‘to have a work displayed (output) in a written text in two or more separate

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languages' (Figs. 3-4 and col. 3, line 64 to col. 4, line 8, and col. 5, lines 27-57), viewing and choosing two or more languages presented adjacently on display (col. 6, lines 47-54 and Figs. 5A-5B), which suggests the system has capability of outputting multiple languages in different combinations, including groups, such as different formats (contents) in one of languages (by language groups), or one of formats in different languages (by groups or common groups). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Yamauchi by providing translating document data in multiple languages and outputting (displaying or printing) the data in different languages, as taught by Flores, for the purpose of being beneficial to users presenting and displaying a written text and its multiple translations in two or more separate languages (Flores: col. 4, lines 5-8).

As per **claim 2**, Yamauchi further teaches "said output unit includes a printing device for printing the translated document in a sheet" (Fig. 1, 'plotter 11').

As per **claim 4**, Yamauchi in view of Flores teaches that "said output unit includes a display for displaying the translated document data" (Yamauchi: Figs. 2 and col. 8, lines 33-34, 'display unit 33').

As per **claim 5**, Yamauchi in view of Flores teaches "an operation unit for specifying an original language and a plurality languages to be translated" (Yamauchi: Figs. 2 col. 7, lines 62, 'system controller', 'input device 32.. used by an operator'; Flore: Figs 2-4, which necessary includes specifying the related languages for the translation).

Claims 6-18 are the same in scope and content as claims 1-2 and 4-5 above and therefore are rejected under the same rationale.

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7. Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over Yamauchi in view of Flores, and further in view of Miyahara et al. (6,314,213 B1) hereinafter referenced as Miyahara.

As per **claim 3** (depending on claim 2), Yamauchi in view of Flores does not explicitly teach “said output includes a sorter for sorting printed sheets by the group”. However, this feature is well known in the art as evidenced by Miyahara who teaches using ‘a sorter 22’ for discharging ‘paper sheet’ (Fig.2) (col. 7, lines 28-29) and ‘a soft key which is used to sort, staple/sort’) (col. 8, line 12). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to combine Yamauchi in view of Flores with Miyahara by providing a sorter and related sorting functionality, as taught by Miyahara, for the purpose of implementing user preferred function, like sorting the resultant sheets, (Miyahara: col. 8, lines 4-13).

Conclusion

8. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a). A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be

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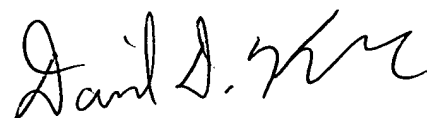
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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Qi Han whose telephone numbers is (571) 272-7604. The examiner can normally be reached on Monday through Thursday from 9:00 a.m. to 7:00 p.m. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Richemond Dorvil, can be reached on (571) 272-7602.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Inquiries regarding the status of submissions relating to an application or questions on the Private PAIR system should be directed to the Electronic Business Center (EBC) at 866-217-9197 (toll-free) or 703-305-3028 between the hours of 6 a.m. and midnight Monday through Friday EST, or by e-mail at: ebc@uspto.gov. For general information about the PAIR system, see <http://pair-direct.uspto.gov>.

QH/qh
December 13, 2005



DAVID D. KNEPPER
PRIMARY EXAMINER